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10/066,005	01/31/2002	Neil D. Scancarella	Rev 01-3	5183

7590

04/23/2003

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/066,005

Applicant(s)

SCANCARELLA ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other:  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, drawn to a method, classified in class 424, subclass 62.
- II. Claims 17-20, drawn to a kit, classified in class 132, subclass 218

Inventions II and I are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the inventions are unrelated since the method of improving aesthetic qualities of a lipstick composition and a makeup kit or apparatus as claimed are not capable of use together and they have different modes of operation, functions, and effects.

During a telephone conversation with Julie Blackburn on April 8, 2003 a provisional election was made with traverse to prosecute the invention of group II, claims 17-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

Specification is objected to for containing derogatory remarks to about prior art. See MPEP § 6708.01 (r); instant specification p. 2, lines 5-20. The applicant may refer to the general state of the art and the advance thereover made by his or her invention, but he or she is not permitted to make derogatory remarks concerning the inventions of others. Derogatory remarks are statements disparaging the products or processes of any particular person other than the applicant, or statements as to the merits or validity of applications or patents of another person. Mere comparisons with the prior art are not considered to be disparaging, per se.

In this case, applicants, referring to the prior art invention in US 6074654, 6071503, and 6019962, state, "[p]atentees claim that this waxy overcoat composition improves the performance of the transfer resistant layer. However, the wear results of such a product appear to vary in consistency between individual so that wear and other aesthetics are somewhat unpredictable." See spec. p. 2, lines 9-12. This remark is viewed subjective, disparaging remarks offered to disprove the merits of the above patents.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17- 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims are vague and indefinite since, while the claims are directed to a "composition", the recited limitations describe a kit or an apparatus, and not a composition of matter.

Claim 19 is objected to as failing to further limit the base claim, claim 18. Claim 18 recites two separate containers sold in one unit; while claim 17 claims a wholly different type of a container.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 17 is rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Nichols et al. (US 6509009 B2) ("Nichols").

Nichols teaches smear-resistant lipcolor composition comprising film-forming resins and a moisturizing glossing composition separately contained in a single kit. See Nichols, col. 1, lines 21 – 30 and claims 19-21.

While the reference is silent as to whether the moisturizing glossing composition is non-reactive, examiner notes that the formulations disclosed contains conventional ingredients for lip compositions such as silicone, lipophilic gelling agent and a

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preservative. The reference teaches that the function of the moisturizing glossing is to “enhance the finish of the cosmetic” by adding “high-gloss finish”. See col. 10, lines 10 – 19. There is nothing in the record to indicate that the moisturizing composition in Nichols is reactive with or alters its colored film-forming composition, and thus examiner views that the prior art moisturizing glossing composition is inherently non-reactive.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drechsler et al. (US 6074654) (“Drechsler”) in view of Litton (US Pat. No. 5970989).

Drechsler discloses method to apply complimentary products, known as “overcoat” or “topcoat” over the film formed after application of the lipstick to enhance

the gloss, shine, and feel. See col. 10, line 63 – col. 16, line 7. The reference also teaches that the overcoating composition “does not significantly disrupt the composition” of the film-forming cosmetic composition. Examples teach that the coloring film-forming composition and overcoating composition are stored in a separate lipstick cases. See instant claim 18.

Litton teaches that cosmetic products designed to be used together are well known in the art, and that “often it is desirable to apply cosmetic and then use various grooming devices to enhance the applied cosmetic”. See col. 1, lines 12 – 29. The reference also mentions that such design allows consumers to carry items such as lipstick with lipliner products, which they would not otherwise. The reference teaches a makeup kit containing a reservoir for lip-gloss or lip gel; and a second compartment for “a product used with the lip gel, in this case a lipliner pencil”. See col. 3, lines 8-23.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have packaged the lipstick and complimentary products of Drechsler into one single stock unit as motivated by Litton because of the expectation that consumers can conveniently carry the complementary products.

2. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drechsler in view of Litton as applied to claims 17-19 as above, and further in view of Nichols.

Drechsler and Litton, discussed above, do not mention makeup remover composition.

Nichols teaches the method of using a make-up remover composition immediately prior to, or after applying the lipcolor composition. See col. 6, lines 54 – 59; col. 12, line 44 – col. 13, line 29. See instant claim 19 and 20.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the makeup kit of the combined references by further incorporating makeup remover product as motivated by Nichols because of the expectation of consumer demands for convenience.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.



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Gina C. Yu  
Patent Examiner  
April 9, 2003



SREENI PADMANABHAN  
PRIMARY EXAMINER

4/18/03